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JOSEPH F. SPANIOL, JR.  
CLERK

No. 90-443

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1990

KERN RIVER GAS TRANSMISSION COMPANY,  
*Petitioner,*

v.

THE COASTAL CORPORATION,  
COLORADO INTERSTATE CORPORATION,  
COLORADO INTERSTATE GAS COMPANY,  
COASTAL WESTERN PIPELINE COMPANY,  
COLORADO INTERSTATE GAS WESTERN  
PIPELINE COMPANY, and  
WYOMING-CALIFORNIA PIPELINE COMPANY,  
*Respondents.*

ON PETITION FOR WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FIFTH CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION

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## QUESTIONS PRESENTED

(1) Whether a mere line depicting a mile-wide environmental corridor within which Petitioner proposed to build a pipeline is subject to copyright protection in light of the doctrine of merger of idea and expression where (i) the line was drawn on pre-existing United States Geological Survey maps in the public domain, and (ii) Petitioner's own witnesses uniformly agreed that a line is the only way to depict the idea for the proposed pipeline route.

(2) Whether this Court should recognize a presumption of irreparable harm in copyright actions seeking a preliminary injunction, when in the pending case (i) this issue was never reached by either the district court or the court of appeals, and (ii) Respondents rebutted any conceivable presumption of irreparable harm.

(3) Whether this Court should determine that a single innocent act of copying of Petitioner's maps by Respondents constituted "fair use" in a case where (i) Respondents had no notice of a copyright claim by Petitioner, (ii) the maps in question contained no copyright notice and were not even registered with the Copyright Office at the time, and (iii) this issue was never reached or addressed by the lower appellate court.

## PARENT AND SUBSIDIARY CORPORATIONS

The following list of Respondents' parent and subsidiary corporations is provided pursuant to Rule 29.1 of the Supreme Court Rules:

- ABCO Aviation, Inc.
- ABCO Leasing, Inc.
- ANG Coal Gasification Company
- ANR Coal Company
- ANR Credit Corporation
- ANR Development Corporation
- ANR Eastern Pipeline Company
- ANR Energy Conversion Company
- ANR Finance B.V.
- ANR Finance N.V.
- ANR Foundation, Inc.
- ANR Freight System Canada Inc.
- ANR Freight System, Inc.
- ANRFS Holdings, Inc.
- ANR Gasification Properties Company
- ANR Gathering Company
- ANR Gulf Pipeline Company
- ANR Intrastate Gas Company, Inc.
- ANR Limited Inc.
- ANR Media Company
- ANR Michigan Storage Company
- ANR One Woodward Corp.
- ANR Pipeline Company
- ANR Production Company
- ANR Ren-Cen, Inc.
- ANR Southern Pipeline Company
- ANR Storage Company
- ANR Supply Company
- ANR Technology Company
- ANR Transmission Company
- ANR Venture Bound Brook Company
- ANR Venture Eagle Point Company
- ANR Venture Management Company
- ANR Western Coal Development Company

ANR Western Storage Company  
American Natural Alaskan Company  
American Natural Offshore Company  
American Natural Resources Company  
Apache Mining Company  
The Belcher Company of New York, Inc.  
The Belcher Company of Tennessee, Inc.  
Belcher New England, Inc.  
Belcher of South Boston, Inc.  
Belcher Oil Company  
Belcher Refining Company  
Belcher Terminals, Inc.  
Belcher Towing Company  
Border Exploration Company  
Brooks Run Coal Company  
Cat Run Coal Company  
CIC Industries, Inc.  
CIG-Canyon Compression Company  
CIG Exploration, Inc.  
CIG Gas Supply Company  
CIG Overthrust, Inc.  
CIG Western Pipeline Company  
Coastal Belcher Petroleum Pte. Ltd.  
Coastal (Bermuda) Limited  
Coastal Border Gas Sales, Inc.  
Coastal Capital Corporation  
Coastal Coal Sales, Inc.  
Coastal Eagle Point Oil Company  
Coastal Energy Corporation  
Coastal Finance Corporation  
Coastal Financial Antilles N.V.  
Coastal Financial B.V.  
Coastal Holding Corporation  
Coastal Libya Exploration Limited  
Coastal Limited Ventures, Inc.  
Coastal Management Services (Singapore) Pte. Ltd.  
Coastal Mart, Inc.  
Coastal Midland, Inc.  
Coastal Netherlands Financial B.V.  
Coastal Offshore Insurance Ltd.

Coastal Oil & Gas Corporation  
Coastal Petrochemical Co., Inc.  
Coastal Petroleum (Far East) Pte. Ltd.  
Coastal Pipeline Company  
Coastal Refinery Marketing B.V.  
Coastal Refining Company  
Coastal Refining & Marketing, Inc.  
Coastal States Crude Gathering Company  
Coastal States Energy Company  
Coastal States Gas Transmission Company  
Coastal States Holding (U.K.) Limited  
Coastal States Industrial Sales Company  
Coastal States Management Corporation  
Coastal States Petroleum (Espana) S.A.  
Coastal States Petroleum (U.K.) Limited  
Coastal States Tankers (U.K.) Limited  
Coastal States Trading, Inc.  
Coastal Tankships U.S.A., Inc.  
Coastal Uranium, Inc.  
Coastal Ventures, Inc.  
Coastal Western Pipeline Company  
Cody Gas Company  
Colbourne Insurance Company, Inc.  
Colbourne Insurance Company Limited  
Cosbel Petroleum Corporation  
Coscol Marine Corporation  
Coscol Petroleum Corporation  
Costa Petro  
Derby Realty Corporation  
Derby Refining Company  
Geogas Enterprise S.A.  
GLGT, Inc.  
Great Lakes Gas Transmission Company  
Holborn Oil Company Limited  
Holborn Oil Trading Limited  
Jayhawk Pipeline Corporation  
Joy Food Stores, Inc.  
Manatee Towing Company  
Mountain Industrial Gas Company  
Pacific Refining Company

Road Equipment  
Skyline Coal Company  
Southern Utah Fuel Company  
Stonehurst Limited  
Sunshine Natural Gas System  
TND Beverage Corporation  
Texas Tank Ship Agency, Inc.  
Texcol Gas Services, Inc.  
Transport USA, Inc.  
Unique Mining Systems, Inc.  
Utah Fuel Company  
Virginia City Coal Company  
Virginia Iron, Coal and Coke Company  
Western Fuel Oil Company  
Wycon Chemical Company  
Wycon Sales Company  
Wyoming Gas Supply, Inc.

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#### ABBREVIATIONS

Record .....	R.
Reporter's Transcript of Proceeding .....	Tr.
Defendant's Exhibit .....	Def. Exh.
Appendix to Supreme Court Petition .....	App.

## STATEMENT OF THE CASE

### A. Factual Background

Petitioner Kern River Gas Transmission Company ("Kern River") and Respondent Wyoming-California Pipeline Company ("Wy-Cal") have over the past several years sought regulatory approval from the Federal Energy Regulatory Commission ("FERC") to construct a natural gas pipeline from Wyoming to California. In the course of pursuing this project, pipeline routes were plotted on numerous pre-existing maps for use by Kern River in connection with seeking regulatory approval and for other purposes.<sup>1</sup>

In May of 1985, Kern River filed with the FERC an application for a certificate of public convenience and necessity to construct the proposed pipeline. In 1985 and 1986, dozens of copies of the maps were generated and provided to the FERC, potential customers, land owners and other parties with a possible interest in the pipeline. Originally, the pipeline routes in issue in this suit were plotted on maps in one of two different scales — a 1:250,000 scale and a 1:24,000 scale, the latter better known as "quad maps."

In January of 1987, at the request of the FERC, The Chambers Group, a private environmental consulting company, prepared a draft environmental impact statement constituting an environmental review of Kern River's proposed route and establishing a mile-wide corridor with the Kern River route as the centerline.

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<sup>1</sup> Respondents urged in the courts below and continue to believe that Kern River is not the true "owner" of the maps in issue for purposes of the federal copyright laws. For purposes of convenience only, this Brief in Opposition sometimes refers to the maps as the "Kern River maps" or "Kern River's maps."

In August of 1987, Wy-Cal also filed an application with the FERC for approval to construct a competitive pipeline. Unlike Kern River, Wy-Cal chose to pursue its application under an "optional expedited certificate" ("OEC") application process adopted by the FERC in 1985. See 18 C.F.R. § 157, Subpart E. The OEC procedure was designed to streamline and substantially shorten the procedures for obtaining a certificate.

In December of 1987, the FERC published the final environmental impact statement ("FEIS") approving the environmental corridor developed by The Chambers Group. The effect of the issuance of the FEIS was that the FERC staff concluded that the construction of a pipeline within the corridor was environmentally acceptable subject to certain mitigation requirements. On December 14, 1987, the FERC gave notice that it would not require an environmental study for portions of the proposed Wy-Cal route that were within one or more previously approved environmental corridors. In January of 1988, Wy-Cal began to create its own quad maps for portions of its proposed route which were outside any approved corridor.

In February of 1988, the FERC served a data request upon Wy-Cal. It asked for quad maps for those portions of the Wy-Cal route not represented to be in common with The Chambers Group/Kern River analysis corridor, as well as maps for a few other specific locations. Wy-Cal created the requested quad maps and included them in response to the data request. As was the case in its original application maps, Wy-Cal prepared all of these maps without reference to or use of any maps alleged to be subject to copyright protection by Kern River.

In March of 1988, The Chambers Group advised Wy-Cal that certain of its maps reflecting adoption of the Kern River analysis corridor deviated from that corridor. The Chambers Group arranged with Wy-Cal for Wy-Cal representatives to visit

The Chambers Group office in Albuquerque in order to plot accurately the centerline of the FEIS corridor.

On April 4, 1988, two Wy-Cal draftsmen visited the offices of the Chambers Group to plot the centerline of the Kern River corridor. The purpose of this visit was solely to obtain the centerline of the analysis corridor in order to assure that Wy-Cal's proposed route fell within the approved environmental corridor. Without identifying their source, The Chambers Group provided certain maps which were a reduced version of the 1986 quad maps for which Kern River later obtained copyright registrations. The Wy-Cal draftsmen were unaware of where the maps came from, and Wy-Cal reasonably believed that it was entitled to obtain the precise location of the centerline of the analysis corridor it had adopted. Wy-Cal's draftsmen plotted on blank pages the centerline of the corridor as reflected by the maps provided by The Chambers Group. Wy-Cal never had knowledge of a claimed copyright on the maps prior to the filing of this suit, which occurred almost a year after the trip to Albuquerque.

Kern River suggests in its Petition that there is some meaningful distinction, for federal copyright purposes, between the 1:250,000 scale maps, for which it has abandoned its copyright claims, and the 1:24,000 scale quad maps. Kern River seems to suggest that a mile-wide environmental corridor was first approved by the FERC, and that Kern River then returned to its drawing boards and developed the precise route for its proposed pipeline. In fact, the opposite occurred. The environmentally approved mile-wide corridor simply reflects a corridor with the proposed Kern River pipeline route as its centerline. Wy-Cal wished to be within the corridor, but was not interested in tracking precisely the Kern River route. Nor could the proposed Kern River route as depicted on its quad maps possibly depict the *exact* location of a 36-inch pipeline which might ultimately be built as Kern River argues. The very width of the line would

measure some 100 feet on the ground, given the scale of the maps on which they were drawn.

In addition, the copies of the maps resulting from the April 4, 1988 Albuquerque incident were not required for Wy-Cal to obtain a FERC certificate. Resolving the apparent deviation of Wy-Cal's proposed route from the approved analysis corridor did not require maps at all. The FERC's regulations have no such requirement. Two witnesses testified that there was no need to submit new maps. Kern River admitted in its own pleadings that it was not necessary for Respondents to submit new maps in order to satisfy Chambers: "They needed merely to indicate orally their intention to follow the Kern River route and that would have sufficed." R. Tab 75 at p. 17

In January of 1989, the FERC entered an order indicating that it intended to grant Wy-Cal its optional expedited certificate. Faced with its competitor's certification to begin construction and still awaiting favorable action on its own request for a certificate, Kern River obtained copyright registrations on a large number of quad maps and 1:250,000 scale maps that had been used in connection with Kern River's FERC filings. The pending litigation was commenced shortly thereafter alleging copyright infringement. Although these maps had been generated in 1985 and 1986, Kern River sought no copyright protection and never advised anyone of its alleged copyrights until after the FERC indicated it was granting a certificate to Wy-Cal three or four years later. Wy-Cal believes that the sole purpose of obtaining the copyright registrations was to obtain a competitive advantage in the pipeline competition through a copyright infringement action. In preparing its application for its certificate, and in responding to the FERC's one data request, Wy-Cal used maps which were generated without referring to any maps later registered by Kern River.

There was no evidence presented that Wy-Cal's application with the FERC in any way delayed or hindered a ruling on Kern River's application, nor was there any evidence that, in the absence of Wy-Cal's sole, innocent act of preparing its own set of quad maps in Albuquerque, Wy-Cal would not have received its certificate. All of the evidence was to the contrary, and at the time of the injunction hearing Kern River's application with the FERC was still pending.

## **B. Procedural Background**

Petitioner initiated this action by bringing suit against Respondents for federal copyright infringement and state law misappropriation in the United States District Court for the Southern District of Texas on March 20, 1989. Petitioner sought a temporary restraining order, a preliminary injunction, and an impoundment order under the federal copyright laws seeking, *inter alia*, impoundment of the certificate issued by the FERC. After giving Respondents only about twenty-four hours notice of a TRO hearing, Kern River obtained a temporary restraining order from the Bench on March 22, 1989, which was followed by a written TRO and impoundment order on March 28, 1989. The TRO and impoundment order covered certain Kern River quad maps as well as certain of its 1:250,000 scale maps.<sup>2</sup>

In May of 1989 the district court conducted a thorough five-day evidentiary hearing on Kern River's request for a preliminary injunction and impoundment order. Both sides submitted extensive briefs and exhibits prior to and following the injunction

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<sup>2</sup> In its Supreme Court Petition, Kern River abandons any argument that the 1:250,000 scale maps are subject to copyright protection.



hearing. Respondents asserted numerous grounds for denying the request for injunctive relief, which can be summarized as follows:

(1) Kern River sought to impound the certificate issued to Wy-Cal by the FERC and to enjoin the use of the benefits of that certificate. The validity of the certificate and Kern River's claim that Wy-Cal had misappropriated its route had been directly raised in FERC proceedings which were at the time on appeal to the United States Court of Appeals for the District of Columbia. Under 15 U.S.C. § 717r(b), the district court in Texas did not have jurisdiction to grant the relief requested. *See, e.g., Atlanta Gas Light Co. v. Federal Power Commission*, 476 F.2d 142 (5th Cir. 1973).

(2) Kern River was not the owner of the copyrights, since employees of other corporate entities had actually prepared the maps. The maps did not qualify as "works made for hire" under 17 U.S.C. §§ 101 and 201, and this Court's interpretation of those statutes in *Community for Creative Non-Violence v. Reid*, 109 S. Ct. 2166 (1989).

(3) Most or all of the mapped route was copied from earlier works by different authors and was therefore not subject to copyright protection. *See* 17 U.S.C. § 103(b).

(4) Under the merger doctrine, the lines on Kern River's USGS maps were not subject to copyright protection.

(5) Kern River's copyrights were invalid due to prior publication and failure to cure. *See* 17 U.S.C. § 405(a).

(6) Kern River had established no causal link between the alleged copying and any alleged injury.

(7) Respondents' activities were privileged under the fair use and implied license doctrines.

(8) Kern River's claims were subject to the defenses of estoppel and laches.

(9) Kern River would not be irreparably harmed if the injunction were denied.

(10) Since Kern River insisted that only one pipeline could be built due to economic realities, Kern River could not establish that the balance of hardships weighed in its favor under Fifth Circuit precedent. *See Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 389-90 (5th Cir. 1984).

(11) Kern River could not establish that granting the injunction would serve the public interest, a separate element to be considered by the district court in ruling on injunction matters. The FERC was created to determine which energy-related projects would best serve the public interest. It had conducted extensive hearings on the competing applications for FERC certificates, and had concluded that Respondent Wy-Cal should be granted a certificate.

On July 18, 1989, the district court entered a memorandum and order dissolving the temporary restraining order, denying the request for preliminary injunctive relief, and ordering the return to Respondents of all documents previously impounded. App. 14a. The Court concluded as follows:

(1) As to the 1:250,000 scale maps, the doctrine of merger applied.

(2) As to the quad maps, the fair use doctrine was applicable.

(3) Not only was there no irreparable harm resulting from Respondents' alleged acts of copying, but Kern River had suffered no damages, irreparable or otherwise, as a result of these alleged acts.

App. 19a-21a.



On May 8, 1990, the Fifth Circuit issued its opinion in the appeal of the denial of the preliminary injunction. App. 1a. The Court reached only the issue of the applicability of the merger doctrine, and concluded that all of Kern River's maps, including the quad maps, were not subject to copyright protection by virtue of that doctrine. Having found no substantial likelihood of success on the merits, the Fifth Circuit expressly pretermitted a decision on the fair use defense, and "any decision on whether Kern River has met its burden on the remaining elements of a prima facie case for a preliminary injunction . . . ." App. 12a-13a. The Fifth Circuit pointed out that "[t]his copyright claim is no more than a harassing skirmish by Kern River against Wy-Cal in the larger fight for domination of this southern California market." App. 7a.

## ARGUMENT

### **A. A Mere Line on a Map Depicting a Proposed Pipeline Route is Not Subject to Copyright Protection**

There is no basis for Petitioner's claims that the Fifth Circuit's decision in this case "negates copyright protection for all maps," and "extends the merger doctrine in a manner which precludes copyright protection for maps in general." Petition at 11-12. Neither Respondents nor the courts below have ever remotely suggested that maps in general are not subject to copyright protection. Whether maps are treated as pictorial or graphic works under 17 U.S.C. § 102, or compilations or derivative works under 17 U.S.C. § 103, no one can dispute that maps in general are subject to copyright protection.

What the Fifth Circuit held, and what Respondents contend, is that a mere line depicting a proposed pipeline route on pre-existing USGS maps in the public domain cannot be copyrighted.

The Copyright Act provides in 17 U.S.C. § 102(b): “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.” This fundamental provision of the Copyright Act states “the basic dichotomy between expression and idea.” 17 U.S.C.A. § 102 note.

Since the copyright laws do not protect ideas, but only the expression of those ideas, the courts have developed the doctrine of merger. Under this doctrine, copyright protection is not available in situations where the idea and expression of that idea become merged, i.e., are one and the same. Where a particular form of expression is an indispensable method of communicating the underlying information, no copyright protection in that form of expression is afforded the author. “Where the ‘idea’ and its ‘expression’ are thus inseparable, copying the ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law.” *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). “Under the copyright doctrine of merger . . . copyright protection will be denied even to some *expressions* of ideas if the idea behind the expression is such that it can be expressed only in a very limited number of ways.” *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986) (emphasis in original). “If there is only one way to express the idea, ‘idea’ and ‘expression’ merge and there is no copyrightable material.” *M. Kramer Manufacturing Co. v. Andrews*, 783 F.2d 421, 436 (4th Cir. 1986).

Kern River’s proposed pipeline route is a paradigm example of the merger of idea and expression. There is simply no other way to express Kern River’s idea — its proposed route for the

pipeline on pre-existing USGS maps — than to draw lines on such maps. Kern River's witnesses repeatedly agreed with this proposition.<sup>3</sup> Edwin Harris, the engineer responsible for the overall direction and coordination of engineering on Plaintiff's project, explained:

Q: How else could that route have been expressed on a USGS map other than how you did it with a single line?

A: To the accuracy we desired, I don't know of another way that I would have done it.

Q: That line is the only way of expressing the ideas embodied in your route, right?

A: That's the only way I would have done it.

Q: Can you think of any other way?

A: No, sir.

Kern River's Project Manager Wadlington testified that the reason a line on the maps was used to express the pipeline route was because he does not "know any other way to do it." Kern River's co-manager Muse similarly stated: "I can't imagine of anything else but a line." Kern River's supervisor of engineering, Robert Sluder, also confirmed the obvious: "A pipeline is a linear facility. . . . I don't know of any other way to express a linear facility than by lines." Sluder later testified: "As far as our idea of our pipeline route for us to express it on a map, the only way for us to do that on a map is to express it as a line." Respondents submit that in the case of a pipeline route, which is only proposed and has no existence in the real world, the idea and the expression of the idea through a line on each quad map are one and the same.

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<sup>3</sup> Def. Exh. 162 at 128-29; Wadlington Dep. at 146; Muse Dep. at 59; Def. Exh. 165 at 121, 123-24; Tr. 243.

The cases cited by Petitioner do not support their contention that the merger doctrine is inapplicable here. *Mazer v. Stein*, 347 U.S. 201 (1954) held that male and female dancing figurines made of china and used as lamp bases could be copyrighted. Obviously, there are infinite ways to depict dancing human figurines. Similarly, *Rockford Map Publishing, Inc. v. Directory Service Co.*, 768 F.2d 145 (7th Cir.), *cert. denied*, 474 U.S. 1061 (1986), held that a plat map was copyrightable. The court stated that “[t]he contribution of a collection of facts lies in their presentation, not in the facts themselves. The collector may change the form of information and so make it more accessible, or he may change the organization and so make the data more understandable.” *Id.* at 149. Neither *Mazer* nor *Rockford Map Publishers* addressed the doctrine of merger, nor would such a discussion have been appropriate under the facts of those cases.

A more apposite case is *Baker v. Seldon*, 101 U.S. 99 (1879), which held that a blank accounting ledger book was not subject to copyright protection. *Baker* quoted an earlier English decision which held that a cricket scoring sheet “was not a fit subject for copyright, partly because it was not new, but also because ‘to say that a particular mode of ruling a book constituted an object for a copyright is absurd.’” *Id.* at 106-07. Respondents submit that if lines in a book are not entitled to copyright protection, the same should be said for a single line on a map.

Even the simplest standard map can involve hundreds of decisions as to the manner in which the information is presented — through colors, form of printing, symbols, and decisions as to what to include and what to exclude. Such is not the case here. There is only one practical way to depict a proposed pipeline route on a pre-existing map — with a line. By Petitioner’s reasoning, a mapmaker could depict the location of a highway or political boundary, and prohibit all other mapmakers from depicting the same information. The shape of a knife or

simple recipes could also be copyrighted. The input of time and effort Kern River may have expended in selecting its pipeline route is irrelevant. *Rockford Map Publishers*, 768 F.2d at 148.

Kern River contends that the Fifth Circuit somehow violated the clearly erroneous standard of Fed. R. Civ. P. 52(a) by not respecting the "fact" findings of the district court. This argument is misplaced for several reasons.

Kern River begins by complaining of one sentence in the Fifth Circuit's opinion which said that extending copyright protection to the quad maps would grant Kern River a monopoly over the only approved pipeline route. This sentence, complains Kern River, is in turn based on the conclusion of an administrative law judge in a FERC proceeding that the market would only support one pipeline. Petition at 19. The reference to the ALJ's finding in the Fifth Circuit opinion was in that part of the opinion addressing the 1:250,000 scale maps. Kern River abandons in its Petition any claim that these maps are copyrightable. Petition at 7. Furthermore, Kern River has repeatedly admitted that the market would in fact only support one pipeline. Its complaint judicially admitted that "economic reality dictates that, in all likelihood, only one pipeline will be built of the kind described by the Kern River project." R. 955. It maintained in its brief to the Fifth Circuit that "only one pipeline is likely to be built on the Kern River Route." Appellant's Fifth Circuit Brief at 12, 24. Respondents submit that whether a line on a map is subject to copyright protection is either a pure question of law, or a mixed question of law and fact where the facts are not in dispute. Rule 52(a) does not apply to questions of law. *United States v. Mississippi Valley Generating Co.*, 364 U.S. 520, 526 (1961). The district court's analysis of the merger question is presented in its conclusions of law, and not in its findings of fact. The Fifth Circuit correctly noted that "[c]ourts have often found it difficult to draw the line between an idea and its expression. . . . 'The

guiding consideration in drawing the line [between an idea and its expression] is the preservation of the balance between competition and protection reflected in the patent and copyright laws.' " App. 10a (citation omitted). Surely such an analysis requires a court to render conclusions of law which are outside the ambit of Rule 52(a).

In addition, Kern River argued at the injunction hearing that questions relating to the merger of idea and expression were not questions of fact, but called for legal conclusions instead. When one of Kern River's witnesses was asked whether, "the idea of the route location that you want to communicate to FERC is exactly the same as the pipeline route in the map you filed with them," Kern River's counsel objected that "I think the question goes to the ultimate question and calls for a legal conclusion . . ." Tr. 416, 418. When the same witness was asked whether "the idea of the location of your pipeline route that you submitted to FERC and wanted them to approve is identical to the line that you furnished them so that they could review that line," counsel for Kern River again objected on grounds that "it's not established that a depiction is an idea or that a pipeline route is even an idea and to characterize it as the idea of the pipeline route simply calls for a legal conclusion on the ultimate question." Tr. at 419-20.

Kern River attempts to draw a meaningless distinction between the larger-scale maps and the smaller-scale maps. Both sets of maps set out the centerline for a mile-wide environmental corridor for which FERC approval was sought. The quad maps simply reflect Kern River's proposed pipeline route, which is also by design the centerline of the environmental corridor for which FERC approval was obtained. Respondents offered un rebutted evidence at the injunction hearing that their only goal was to be within the corridor, and that they had no plans to follow Kern River's exact route. *E.g.*, Tr. 331. Furthermore, the Kern River route does not and cannot possibly depict the exact location of a



thirty-six inch wide pipeline. *See* Petition at 8. Kern River itself brought out in its cross-examination at the injunction hearing that the width of the line itself on the maps, if blown up to life-size scale, would measure some 100 feet. Tr. 553. The Fifth Circuit correctly concluded that, regardless of a map's scale, a mere line on it depicting a proposed pipeline route is subject to the merger doctrine.

**B. There is No Clear Conflict in the Circuits on a Presumption of Irreparable Harm; This Issue Was Not Even Reached by the Lower Courts; and Any Such Presumption Was Rebutted in the Pending Cause**

In asking this Court to grant certiorari on the issue of whether or not there is a presumption of irreparable harm in copyright infringement actions, Kern River suggests a "direct and acknowledged" conflict in the circuits where none exists, on an issue that was not even reached by the lower courts, and that in any event would not affect the outcome of the pending cause.

It is clear that neither the district court nor the Fifth Circuit addressed the issue that Kern River now asks the Supreme Court to entertain. At the district court level, Judge Hoyt did not need to reach the issue, because he concluded that Kern River had not suffered *any* injury as a result of the alleged copying, much less *irreparable* injury. Judge Hoyt concluded that no evidence was presented that copying of the quad maps was necessary to the FERC approval process, and that "[a]t this point, the evidence does not establish the damages. . . . The Court is of the opinion that, while Kern River may have suffered damages and may prevail *at the time of trial* on the merits, those damages will exist only if Kern River is required to alter its route . . . and if Kern River is issued a certificate of public necessity and convenience with which construction may commence." App. 20a-21a (emphasis added). Likewise, the Fifth Circuit reached only the element of likelihood of success on the merits, and expressly

pretermitted the other elements for obtaining an injunction, including irreparable harm. App. 12a-13a.

For this reason alone, the Court should be reluctant to grant certiorari on this issue. *J. Truett Payne Co. v. Chrysler Motors Corp.*, 451 U.S. 557, 568 (1981) ("We do not ordinarily address for the first time in this Court an issue which the Court of Appeals has not addressed. . . ."); *Patrick v. Bruget*, 486 U.S. 94, 98 n.5 (1988) ("This Court usually will decline to consider questions presented in a petition for certiorari that have not been considered by the lower court."); C. Wright, A. Miller, & E. Cooper, *Federal Practice & Procedure* § 4036 (1988) ("Even if an issue has been properly presented, the Supreme Court is ordinarily reluctant to decide issues that have been passed over by the lower courts.").

Kern River suggests that this Court needs to resolve a conflict in the circuits on this issue. Respondents question whether such a conflict exists. The Fifth Circuit has not squarely reached the issue of whether a presumption of irreparable harm arises in preliminary injunction actions brought for copyright infringement. In *Plains Cotton Co-Operative Association v. Goodpasture Computer Service, Inc.* 807 F.2d 1256 (5th Cir. 1987), the Fifth Circuit simply held that such a rule "is not established in this Circuit," *id.* at 1261, and went on to conclude that the appellant's alleged damages appeared to be quantifiable and compensable in money damages. *Plains Cotton* quoted the Fifth Circuit's prior opinion in *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 390 (5th Cir. 1984), confirming that "[t]his Circuit has not expressed a view on whether a presumption of whether irreparable injury (the second prong) as a matter of law is appropriate after a substantial likelihood of success on the merits is shown."

Respondents also cannot agree with Kern River's contention that a presumption of irreparable harm is critical to the present



case, Petition at 23, for two reasons. First, since the merger doctrine applies and the maps in issue are not subject to copyright protection, Kern River did not make a prima facie case of infringement, and no presumption of irreparable harm should therefore apply even under the cases Kern River cites.

Second, and more important, none of the cases cited by Kern River even remotely suggests that a presumption of irreparable harm cannot be rebutted. In the pending case, Respondents overwhelmingly rebutted any presumption that could have arisen.

The evidence presented to the district court established that the one alleged incident of copying on April 4, 1988 in no way influenced the FERC to issue Wy-Cal its certificate. Tr. 334, 581. The evidence showed that there was no access to or use of any maps which depicted the Kern River route prior to April of 1988, and hence that Wy-Cal could not have used any Kern River maps in connection with its actual application filed with the FERC or in its response to the FERC's one data request, which was served in February of 1988. Tr. 321-22; Tr. 18, 20, 24, 27, 70 (May 26, 1989). Hence, Judge Hoyt was perfectly logical in concluding that "[n]o evidence was presented that Wy-Cal's copying of the Kern River's quad maps were necessary to the FERC approval process . . . at this point, the evidence does not establish the damages." App. 20a. In addition, evidence was presented, and Kern River in fact admitted in its own pleadings, that Wy-Cal could have orally adopted the Kern River route without physically copying any of the maps. Tr. 641-42; Record Tab 75 at 17. Furthermore, there was no evidence presented that the alleged copying in any way hindered the FERC's deliberations on the Kern River application. Hence, Judge Hoyt was on firm ground in concluding that "while Kern River may have suffered damages and may prevail at the time of trial on the merits, those damages will exist only if . . . Kern River is issued a certificate of

public necessity and convenience with which construction may commence." App. 21a.

One of Kern River's own witnesses also confirmed that its records would permit it to quantify the alleged damages which had occurred, and another Kern River witness confirmed that if Wy-Cal had paid Kern River, in September of 1987, for a reasonable share of Kern River's claimed expenses, Wy-Cal could have used the information contained in the Kern River maps without objection. R. 472-73; Def. Exh. 165 at 72-73. The federal courts are in uniform agreement that an alleged injury is not irreparable if it can be compensated through monetary damages.<sup>4</sup>

Respondents submit that this case stands in contrast to those cases cited by Petitioner where there is a realistic and practical concern that a defendant will continue to copy and sell a copyrighted work, resulting in future lost profits which may be difficult or impossible to measure. In this case, any injury to Petitioner as a result of an alleged single act of copying which occurred in 1988 is compensable in money damages. Even the cases cited by Petitioner do not go so far as to suggest that a presumption of irreparable injury is always appropriate in a copyright infringement action.<sup>5</sup>

<sup>4</sup> E.g., *Deerfield Medical Center v. Deerfield Beach*, 661 F.2d 328, 338 (5th Cir. 1981); *Irre Feit & Drexler, Inc.* 760 F.2d 406, 416 (2d Cir. 1985); *Holley Sugar Corp. v. Goshen Sugar Corp. Cooperative Beet Growers Association*, 725 F.2d 564, 570 (10th Cir. 1984).

<sup>5</sup> For example, the first three cases cited by Petitioner do not state such a hard and fast rule. See *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 611-12 (1st Cir. 1988) ("Irreparable harm is *usually* presumed if likelihood of success on the copyright claim has been shown.") (emphasis added); *Rushton v. Vitale*, 218 F.2d, 434, 436 (2d Cir. 1955) ("When a *prima facie* case for copyright infringement has been made, plaintiffs are entitled to a preliminary injunction without a *detailed* showing of danger of irreparable harm.") (emphasis added); *Uneeda Doll Co. v. Goldfarb*

Respondents do not believe that this Court's opinion in *Sony Corporation of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), requires a presumption of irreparable injury in cases where copying is for commercial gain, for several reasons. There the Court stated that a likelihood of future harm "may" be presumed where the intended use of the copying is for commercial gain. *Id.* at 451. The Court clearly used the word "may" rather than "must" or "should." Second, Kern River quotes from that section of the opinion which analyzed the fair use defense. The Supreme Court was not addressing whether irreparable injury should be presumed when a party seeks a preliminary injunction. Instead, the Court was addressing whether a likelihood of future harm may be presumed under a fair use analysis. Third, the language quoted is clearly dicta, in that the *Sony* case dealt with home use of video tape recorders, which "must be characterized as non-commercial, non-profit activity." *Id.* at 448.

Finally, Respondents would note that the Copyright Act does not mandate a presumption of irreparable harm. The provision cited by Petitioner, 17 U.S.C. § 502(a), provides only that courts of competent jurisdiction may "grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright."

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*Novelty Co.*, 373 F.2d 851, 852 (2d Cir.) (same), *cert. dismissed*, 381 U.S. 801 (1967).

**C. The Court of Appeals Did Not Even Reach, Much Less Violate, This Court's Interpretations of the "Fair Use" Defense Under Section 107 of the Copyright Act**

Kern River complains that the Court of Appeals ignored the issue of fair use which it had raised in its appeal from the denial of the injunction. The Fifth Circuit did not reach the issue of fair use because it correctly concluded that the quad maps in question were not copyrightable by virtue of the doctrine of merger, and that hence there was no need to reach this issue. App. 12a.<sup>6</sup> As with the issue of irreparable harm, therefore, the Court should be reluctant to grant certiorari on this issue.

Regardless, Respondents established in the district court that they were entitled to invoke the fair use defense. Four non-exclusive factors to consider in making a fair use determination are provided in 17 U.S.C. § 107: (1) the purpose and character of the use, including whether such use is of a commercial nature or for non-profit or educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.

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<sup>6</sup> Kern River asserts in its Petition that the fair use issue was the "single substantive issue" presented to the Fifth Circuit on appeal. Petition at 28. On the contrary, numerous other substantive issues were presented, including jurisdiction, ownership of the copyrights, invalidity of the copyrights due to prior publication and failure to cure, and lack of causation. Respondents properly raised these issues in the Fifth Circuit as independent grounds for concluding that the district court was correct in denying the injunctive relief requested. See, e.g., *Colautti v. Franklin*, 439 U.S. 379, 397, n.16 (1979) ("Appellees, as the prevailing parties may of course assert any ground in support of that judgment, 'whether or not that ground was relied upon or even considered by the trial court'"); *Terrell v. University of Texas System Police*, 792 F.2d 1360, 1362 n.3 (5th Cir. 1986) ("When the judgment of the district court is correct, it may be affirmed on appeal for reasons other than those given or relied on below."), *cert. denied*, 479 U.S. 1064 (1987).

The district court made factual findings on each of these factors, and, in considering the "totality of the circumstances," concluded that the fair-use doctrine was applicable in this case. As to the first factor, the court was obviously aware that Respondent Wy-Cal was in commercial competition with Kern River and that any alleged copying was for commercial purposes. It was obviously aware that the maps were created for informational purposes as opposed to creative or artistic purposes, and noted the extent to which the maps had been distributed and hence that they were not of an unpublished nature. It also made fact findings as to which of Kern River's numerous copyrighted maps had been copied. As to the economic impact of the alleged copying, the court found that no damages had occurred, since the use of Kern River's quad maps were unnecessary to the FERC approval process. App. 16a-21a.

The Court did not err in looking to the "totality of the circumstances" in making a fair-use determination. "The doctrine is an 'equitable rule of reason,' which 'permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.'" *Stuart v. Abend*, 110 S.Ct. 1750, 1768 (1990) (citations omitted). "Beyond a broad statutory explanation of what fair use is and some criteria applicable to it, the courts must be free to adapt the doctrine to particular situations on a case-by-case basis." *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 448 (1984) (quoting H.R. Rep. No. 94-1476). Hence, this Court has noted that "fair-use analysis must always be tailored to the individual case." *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 552 (1985).

The defendant's state of mind is relevant to the question of fair use. *E.g., Key Maps, Inc. v. Pruitt*, 470 F. Supp. 33 (S.D. Tex. 1978); *New York Tribune, Inc. v. Otis & Co.*, 39 F. Supp. 67, 68 (S.D.N.Y. 1941). In this case, the district court found that

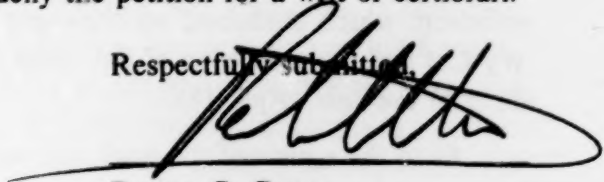
the alleged copying was totally innocent, in that Wy-Cal's draftsmen were unaware of any claim of copyright as to the maps they reviewed, which contained no copyright notice, and that indeed Wy-Cal had no knowledge of the claim of copyright prior to the filing of the suit. App. 18a.

As to the nature of the work, the scope of fair use is greater where, as here, informational works as opposed to artistic or creative works are involved. *Harper & Row Publishers, supra* at 563. Likewise, the unpublished nature of a work is deemed to be a critical element of its "nature," and a fair use defense is viewed less favorably when the work is unpublished. *Id.* at 564. Respondents put on evidence that the maps in question were published on many occasions to virtually anyone who requested a copy. Tr. 206-36. Based on all of these circumstances, the district court was within its discretion in determining that a single, innocent act of copying a single line on maps which were not even registered with the Copyright Office until months later, and which bore no indication of proprietary rights, fell within the fair use doctrine.

**CONCLUSION**

The Court should deny the petition for a writ of certiorari.

Respectfully submitted,

A large, stylized handwritten signature in black ink, likely belonging to Robin C. Gibbs, is written over the "Respectfully submitted," text.

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